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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,872	09/22/2003	Takehiko Nakano	09812.0377-00000	1172
22852 7590 08/21/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER SHAN, APRIL YING	
			ART UNIT 2135	PAPER NUMBER
			MAIL DATE 08/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/667,872

Applicant(s)

NAKANO, TAKEHIKO

Examiner

April Y. Shan

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-15 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-15 and 17-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. A Request for Continued Examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8 June 2007 has been entered.
2. Claims 1, 7, 12, 18, 22 and 23 have been amended. Claims 5 and 16 have been canceled. No new claims have been added. Claims 1-4, 6-15 and 17-23 are currently pending in the present application.
3. Applicant's amendments and argument have been fully considered, but are moot in view of new ground rejection as set forth below. It is noted that Applicant's arguments are directed towards limitations newly added via amendments.
4. Any objections or rejections not repeated below for record are withdrawn due to Applicant's amendment/explanation/cancellation.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 10 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per **claims 10 and 21**, "charges fees for changing the maximum number of times identification information can be replaced" is being recited. However, on page 9 of the original disclosure, the Applicant discloses, "...charging depending on the maximum allowable number of times already registered identification information is changed". It appears to the examiner, charging depending on the maximum allowable number of times already registered identification information is changed means charges depends on the changed maximum allowable number of times, not for charge fees for changing the maximum number of times identification information can be replaced.

The examiner respectfully and carefully reviews the Applicant's argument on pages 7-8 of the remark and the disclosure on page 34, but it is not persuasive. On page 34 of the original disclosure, the Applicant only discloses "The limitation imposed on registration is allowed to be **changed**. For example, as a service which needs payment, the maximum number of times registration information may **be allowed to be rewritten** is changed from 5 to 10." The cited disclosure only supports a service needs payment, the registration is allowed to be changed, **not is allowed to be changed with charge**.

Therefore, "charges fees for changing the maximum number of times identification information can be replaced" recited in the claim is a new matter and does not supported by the original disclosure.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 23 defines a medium containing processor readable instructions embodying functional descriptive material. However, the claim does not define a computer readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized: - Guidelines Annex IV). That is, the scope of the presently claimed medium can range from paper on which the computer program is written, to a computer program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the computer program on "a computer-readable medium" or equivalent in order to make the claim statutory. Any amendment should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 103

8. Claims 1-4, 6-15 and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ansell et al. (U.S. Patent 6,792,113) and in view of Lauper et al. (U.S. Patent 6,726,100).

As per **claims 1, 7, 12 and 18**, Ansell et al. discloses a content usage control apparatus/method for controlling use of a content under a predetermined condition, comprising:

acquiring first identification information for a first client, the first client being an apparatus or user requesting use of the content ("authentication server sends an information template for new machine bound passports. An information template is a collection of data specifying user-supplied data fields and prompts therefore. The information template is an XML description of the data to collect from the user... Such information can be entered by the user using conventional user-interface techniques. Processing transfers to step 810" – e.g. col. 16, lines 37-50);

registering the first identification information acquired from the first client ("In step 810, content player 142 sends hardware identifier 140 and any user-supplied information to authentication server 126 as a request for a new machine-bound passport... Logic flow diagram 900 (fig. 9) illustrates processing by authentication server 126 (fig. 1) in response to a request for a new machine-bound passport made by content player 142 in step 810 (fig. 8)... authentication

server 126 associates the new certificate with the received hardware identifier, within certificate database...” – e.g. col. 16, lines 53-67 – col. 17, lines 1-23);

changing the registered first identification information and preventing further changes to the registered first identification information in accordance with a limitation (e.g. col. 17, lines 27- 58);

in response to the request for use of the content issued by the first client, determining whether the use of the content is allowed on the basis of whether the first identification information is currently registered (“content player determines whether the entered password corresponds to the full passport. If the password corresponds to the selected full passport, processing transfers to step 708 in which processing of the purchase for content continues” – e.g. col. 15, lines 13-16 and col. 15, lines 23-28; “content player determines whether hardware identifier is the hardware identifier corresponding to the machine-bound passport located by content player. If hardware identifier is the correct identifier, processing transfers from test step 714 to step 708 and the purchase process continues and any purchased content is bound to a machine-bound passport” – e.g. col. 15, lines 56-59, col. 16, lines 9-13, col. 18, lines 9-24, fig. 7 and fig. 10).

Ansell et al. does not expressly disclose modifying the limitation on changing identification information and the limitation can be a predetermined period of time.

However, Lauper et al. discloses modifying the limitation on changing identification information and the limitation can be a predetermined period of time

(e.g. abstract, col. 1, lines 15-30, col. 2, lines 38-47, col. 4, lines 23-46 and claim 1)

Thus, it would have been obvious to a person with ordinary skill in the art to apply the technique of modifying the limitation on changing identification information and the limitation can be a predetermined period of time as taught in the Lauper et al's reference, to improve the a content usage control apparatus/method of Ansell et al. for the predictable result of provide convenience to purchasers of digital data since purchasers of digital data have a relatively low tolerance for inconvenience, in particular, when a user loses a machine-bound passport.

As per **claims 2 and 13**, Ansell et al. – Lauper et al. disclose a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses registration is performed in response to a request issued by the first client (e.g. logic flow diagram 718 in fig. 8 and logic flow diagram 900 in fig. 9).

As per **claims 3 and 14**, Ansell et al. – Lauper et al. disclose a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses new registration is performed only when a current number of registrations is smaller than a predetermined maximum allowable number of registrations ("logic flow diagram by authentication server in response to a

request for a new passport which includes full passport information... Typically, full passports are permitted to hold only a limited number of additional keys such that users cannot collect machine-bound keys and content from friends and colleagues without limitation. Passport key limit 1912 specifies a maximum number of keys held by a passport based upon key record. Authentication server compares the number of keys already held in the full passport of the user to the limit specified in passport key limit to determine whether the passport can include more keys” – e.g. col. 22, lines 3-48 and step 912 in fig. 9).

As per **claims 4 and 15**, Ansell et al. – Lauper et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses an invalidation flag (Ansell et al.’s key pair associated with hardware identifier 140 (fig. 1) corresponds to the Applicant’s invalidation flag) for controlling provision of a service to the first client is stored together with the first identification information of another apparatus or user (e.g. col. 17, lines 24-26 and step 904 in fig. 9); and the use of the content by the first client is limited, if the invalidation flag associated with the first client is set (col. 17, lines 26-44).

As per **claims 6 and 17**, Ansell et al. – Lauper et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses wherein the limitation is a maximum number of times identification information can be replaced (e.g. col. 17, lines 24 - 58).

As per **claims 8 and 19**, Ansell et al. – Lauper et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses wherein when the registered first identification information for the first client is replaced with second identification information for a second client, the second client is requested to perform a particular operation ("In addition, since the user-bound passport is not bound to any particular hardware identifier, the content and the user-bound passport can be moved from computer system to computer system and can be played back with only the effort required to enter the user's password and to view the user's private information" – e.g. col. 3, lines 40-46).

As per **claims 9 and 20**, Ansell et al. – Lauper et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses wherein when the registered first identification information is replaced with second identification for a second client, submission of change permission information is requested from the second client or manager ("Logic flow diagram 900 (fig. 9) illustrates processing by authentication server in response to a request for a new machine-bound passport made by content player in step 810 (fig. 8) " – e.g. col. 16, lines 58-61).

As per **claims 10 and 21**, Ansell et al. – Lauper et al. discloses a content usage control apparatus/method as applied in claims 6 and 17. Ansell et al. further discloses charging fees for changing the maximum number of times identification information can be replaced (e.g. col. 3, lines 3-9, col. 17, lines 39-58, col. 10, lines 60-63, col. 21, lines 9-19).

As per **claims 11 and 22**, Ansell et al. – Lauper et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses when the limitation is modified, submission of change permission information is requested from a different apparatus or a manager ("Logic flow diagram 900 (fig. 9) illustrates processing by authentication server in response to a request for a new machine-bound passport made by content player in step 810 (fig. 8) "– e.g. col. 16, lines 58-61).

As per **claim 23**, Ansell et al. – Lauper et al. discloses the claimed method of steps as applied above in claim 1. Therefore, Ansell et al. – Lauper et al. discloses the claimed for computer program described in a computer-readable format carrying out the method of steps.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO-892)


Art Unit: 2135

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


15 August 2007
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